

ESTTA Tracking number: **ESTTA681982**

Filing date: **07/06/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85913125
Applicant	The National Association of Professional
Applied for Mark	HOUSTON BUFFS
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Submission	Applicant's Motion to Suspend
Attachments	Motion to Suspend re HOUSTON BUFFS Appeal.pdf(481780 bytes)
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Date	07/06/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of:

Serial No.: 85/913,125
Mark: HOUSTON BUFFS
Applicant: The National Association of Professional Baseball Leagues, Inc.
Filing Date: April 24, 2013
Trademark Attorney: Alison F. Pollack
Law Office: 106

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box. 1451
Alexandria, Virginia 22313-1451


MOTION TO SUSPEND

Pursuant to § 1213 of the Trademark Trial and Appeal Board Manual of Procedure (the “TBMP”), Petitioner The National Association of Professional Baseball Leagues, Inc. (“Minor League Baseball” or “Applicant”) hereby moves to suspend the above-captioned Appeal pending the conclusion of the existing settlement discussions with the Cited-Registrant. Minor League Baseball believes good cause exists to support the requested suspension as the outcome of the settlement discussions may be dispositive of the issue at the heart of the Appeal. This Motion to Suspend is filed prior to the issuance of the Trademark Trial and Appeal Board’s (the “Board”) decision regarding the Appeal and prior to the filing of the Trademark Attorney’s brief. Accordingly, Applicant respectfully asks the Board to suspend the instant Appeal.

MEMORANDUM IN SUPPORT

Applicant respectfully asks the Board to suspend the instant Appeal pending the outcome of its potentially dispositive settlement discussions.

I. Background & Settlement Discussions

Minor League Baseball owns Application Serial No. 85/913,125 for  “HOUSTON BUFFS and design” in Class 25 for use with “[b]aseball related clothing, namely, caps, and t-shirts sold to promote the nostalgia of historic baseball teams that existed within Minor League Baseball[.]” first used, at least as early as, January 1, 1995. During the prosecution of HOUSTON BUFFS and design, the Examining Attorney refused to register the mark on the grounds that it was likely to cause confusion with the following marks, which are all owned by The Regents of the University of Colorado:

- BUFFS—entertainment services in the nature of college sports in Class 41. Registration No. 4,301,429. Date of First Use: 1934.
- BUFFS—clothing, namely, t-shirts, sweatshirts, sweatpants, shorts, socks and hats in Class 25. Registration 4,405,845. Date of First Use: January 20, 2000.
- BUFFS 4 LIFE—charitable fundraising services in Class 36. Registration No. 3,634,016. Date of First Use: June 30, 2007.
- FOREVER BUFFS—business cards, note pads, decals, and pens in Class 16; clothing, namely, t-shirts and polo shirts in Class 25; and association services, namely, promoting the interests and networking of the alumni of a university. Registration No. 3,939,747. Date of First Use: December 1, 2008.

Minor League Baseball narrowed the description of goods listed in its HOUSTON BUFFS design mark application. As a result, the Examining Attorney withdrew the Section 2(d) refusal with regard to BUFFS Registration No. 4,301,429—the only mark with priority over the HOUSTON BUFFS design mark—and made the refusals with regard to the remaining Cited-

Registrations final. Minor League Baseball filed a timely appeal and contacted The Regents of the University of Colorado (“CU”) to discuss the possibility of a consent agreement.

Minor League Baseball and CU continue to discuss a consent agreement with regard to the HOUSTON BUFFS design mark application. CU has been very responsive. Both Minor League Baseball and CU have articulated their respective positions and concerns and have exchanged draft consent agreements—with each communication coming closer to resolution. As such, additional time is needed to discuss the final details and secure signatures from the relevant entities.

II. TBMP Rule 1213

TBMP Rule 1213 states the following, in pertinent part:

“Prior to the issuance of the Board’s decision in an ex parte appeal, proceedings with respect to the appeal **may** be suspended by the Board upon written request by the applicant showing good cause for the requested suspension.” (Emphasis added & citations omitted.)

The use of “may” in TBMP Rule 1312 gives the Board discretion to suspend an appeal based on the applicant’s written request articulating good cause. *See Gaylord Bros., Inc. v. Strobel Products Company, Inc.*, 1963 WL 7888, at *2 (noting that an unrelated Trademark Rule “appears to be permissive rather than mandatory” due to the use of the word “may”). Of course, the TBMP offers examples of situations where it may suspend proceedings in an appeal:

- (1) The applicant is involved in a civil action, or a Board inter partes proceeding, that may be dispositive of the issue(s) involved in the appeal—the Board may suspend pending final determination of the civil action or Board inter partes proceeding.
- (2) Another application that involves the same issue is also on appeal to the Board—the Board may suspend pending final determination of the appeal in the other application.

(3) A registration cited as a reference, under Trademark Act § 2(d), against applicant's mark is due, or will soon be due, for an affidavit of continued use (or excusable nonuse) under Trademark Act § 8 or Trademark Act § 71, or for an application for renewal under Trademark Act § 9 or Trademark Act § 70, The Board may suspend the appeal pending determination of whether the registration will continue in existence or will, instead, be cancelled or expire. If an applicant requests suspension based on the possibility that the cited registration may be cancelled for failure to file an affidavit of continued use, the Board will grant such request if the Board acts on the request after the 5th anniversary of the issue date of the registration. If an applicant requests suspension based on the possibility that the cited registration will expire for failure to renew it, the Board will grant such request if the Board acts on the request after the 9th anniversary of the issue date or the renewal date for the registration. (Citations omitted.)

It is Applicant's understanding, however, that the use of "may" gives the Board broader discretion than the examples articulated in the TBMP; that the fundamental policy behind the examples stated above is to suspend matters that can be resolved by activities or proceedings that exist outside of the appeal so as to not require the expenditure of resources by the Board or Trademark Examining Attorneys that would prove unnecessary. Here, Minor League Baseball and CU have been amicable in their discussions and a resolution via a consent agreement is only days away. As such, Minor League Baseball does not wish to go on record as adversarial to CU, as the case would be if Minor League Baseball is forced to file petitions to cancel the cited registrations owned by CU. Accordingly, Minor League Baseball respectfully requests that the Board exercise its discretion to suspend this Appeal, if only for a limited time.¹ Moreover, Minor League Baseball believes good cause exists to support a suspension of the Appeal. Specifically, suspending the Appeal at this junction would allow Minor League Baseball and CU additional time to secure a consent agreement. Granting such a suspension is consistent with the spirit of the rule as the consent agreement would dispose of the need for the Appeal and would

¹ Minor League Baseball does not foresee the need for anything more than twenty (20) days to finalize and memorialize the agreement between Applicant and the Cited Registrant.

relieve both the Board and the Examining Attorney of the need to expend resources related to the Appeal. Accordingly, Minor League Baseball believes suspending the Appeal pending resolution of the settlement discussions promotes judicial economy and the efficiency of the TTAB.

Minor League Baseball further notes The Board has not yet issued a decision with regard to the Appeal, as required by *In re Vycom Electronics Ltd.* No. 36-86, 1986 WL 83771, at *1. In *Vycom Electronics*, the applicant asked the Board to suspend—in light of its proceedings to cancel registrations that served as the basis of refusal. However, The Board rejected this request because it had already rendered a final decision on the appeal, and the Commissioner agreed. Here, the Appeal is just beginning as neither party has filed its brief.

Minor League Baseball respectfully asserts that good cause exists in support of its Motion to Suspend. Because the Minor League Baseball and CU are close to a resolution that will render the Appeal moot, Applicant respectfully asks the Board for a short suspension of the Appeal pending the outcome of the settlement discussions.

Respectfully submitted,

The National Association of Professional Baseball
Leagues, Inc.

Date: July 6, 2015

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